

## **ELECTION WITH TRAVERSE**

The Office Action has imposed a restriction requiring election of one of four (4) distinct inventions (Groups):

- I. Claims 4 and 5;
- II. Claim 6;
- III. Claim 7; and
- IV. Claims 8-10.

The Applicant provisionally elects invention II, Claim 6, with traverse.

## **REMARKS**

The Office Action has made a restriction requirement based on inventions (Groups) I, II, III, and IV being related each to the others as combination and sub-combination. This is clearly an improper restriction requirement as: (i) ones of the Groups are not in a combination/sub-combination relationship, (ii) two-way distinctness does not exist between the Groups, and (iii) there is no serious burden on the examiner.

The Groups are not in a combination/sub-combination relationship.

The restriction of Group I from Group II is improper. With respect to utility, Group I is generic to Group II. Group I is directed to a method of adapting a block cipher device comprising the step of effectively inhibiting the operation of the most downstream

of modulo operator in a block cipher device and its scope of utility encompasses utility of Group II as a method of selectively adapting a plurality of block cipher devices comprising the steps of providing a first key generator having two equal sections of symbols, each section a function replica of a second key generator, replicating the second key in both sections of the first key, using the symbols provided by one of the two sections to encode and decode the signal in a first stage, and combining the symbols provided by the two sections of the first key generator to cancel the symbols applied to a second stage. Therefore, two way distinctness does not exist with respect to Groups I and II. The restriction requirement is improper and should be withdrawn and Groups I and II examined.

The Office Action has provided no arguments demonstrating that Groups III and IV are separate and distinct. The Office Action merely provides arguments of how Groups III and IV have a separate utility. Groups III and IV are both directed to a block cipher device for encrypting and decrypting information in a cryptographically secured digital communication system, thus, defeating two way distinctiveness. The restriction requirement regarding Groups III and IV are improper and must be withdrawn.

It should be further noted that while the inventions defined by Groups I and II include process claims and the inventions defined by Groups III and IV include apparatus claims, it is perfectly appropriate to examine claims in a single application directed to both apparatus and process claims where the apparatus can be used to practice the process or any part thereof. *See* MPEP § 806.06. The apparatuses defined by both Groups III and IV are directed to a block cipher device for encrypting and decrypting information in

a cryptographically secured digital communication system. The method defined by Group I is directed to adapting a block cipher device in a cryptographically secured digital communication system comprising the step of effectively inhibiting the operation of the most downstream of modulo operator in a block cipher device, and the method defined by Group II is directed to selectively adapting a plurality of block cipher devices in a cryptographically secured digital communication system. Clearly, the apparatuses defined by Groups III and IV may be utilized to practice at least a part of the process defined by Groups I and II. Therefore, the restriction requirement is improper and should be withdrawn and all Groups examined.

The restriction requirement has failed to meet the criteria for proper restriction requirements.

There are two criteria for a proper restriction requirement between patentably distinct inventions:

(A) The inventions must be independent (see MPEP Section 802.01, Section 806.04, Section 808.01) or distinct as claimed (see MPEP Section 806.05 – Section 806.05(i)); **and**

(B) There must be a serious burden on the examiner if restriction is required (see MPEP Section 803.02, Section 806.04(a) – Section 806.04(i), Section 808.01(a), and Section 808.02).

See MPEP § 803 (emphasis supplied). The Action has failed to meet its burden for either criteria.

First, the inventions are distinct if it can be shown that a combination as claimed:

(A) does not require the particulars of the sub-combination as claimed for patentability (to show novelty and unobviousness), and (B) the sub-

combination can be shown to have utility either by itself or in another materially different combination. When these factors cannot be shown, such inventions are not distinct.

*See* MPEP § 806.05(c). In contrast to the guidelines delineated by the MPEP and recited above, the present Action provided a conclusory statement that

“[i]nventions 1-4 are related as sub-combinations disclosed as usable together in a single combination” and provided assertions of utility for each invention while improperly reciting elements of the pending claims. The Action, however, does not address how the two or more alleged sub-combinations are disclosed as usable together in a single combination and provides no factual basis with regard thereto. The Action’s conclusory statements with no evidence or factual reasoning cannot render a proper restriction. *See* MPEP § 816.

Further, the fact that **both the two-way distinctness and serious burden criteria must be satisfied** is made all the more clear by the following statement in the MPEP:

If the search and examination of an entire application can be made without serious burden, the examiner **must** examine it on the merits, even though it includes claims to independent or distinct inventions.

*See* MPEP § 803 (emphasis supplied). Thus, if the subject matter of the pending claims is such that there would be no serious burden on the examiner to search and examine all of the pending claims at the same time, the examiner is to do so, even if the pending claims are drawn to independent or distinct inventions.

**In the instant case, the pending claims have already been examined as evidenced by the two previous substantive Office Actions mailed March 24, 2005**

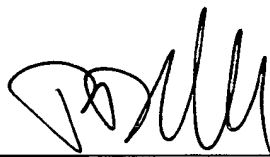
**and September 20, 2005.** Thus, there is no serious burden in this case. Applicant respectfully submits that the criteria for examining all of the pending claims is met in the instant application. Accordingly, reconsideration and withdrawal of the restriction requirement is respectfully requested.

## Conclusion

The restriction requirement must be withdrawn for the following reasons: (i) ones of the Groups are not in a combination/sub-combination relationship, (ii) two-way distinctness does not exist between the Groups, and (iii) there is no serious burden on the examiner.

The Applicant requests withdrawal of the restriction requirement and examination of claims 4-10. In view of the previous substantive examination in the subject application, the Applicant submits that the present claims are in condition for allowance and such action is solicited.

Respectfully submitted,



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